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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/430,644	10/29/1999	ROBERT NORMAN HURST	SAR-13543	7580

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EXAMINER

AN, SHAWN S

ART UNIT	PAPER NUMBER
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2613

DATE MAILED: 07/02/2004

20

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/430,644

Applicant(s)

HURST, ROBERT NORMAN

Examiner

Shawn S An

Art Unit

2613

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-12, 14-20, and 22-24 is/are rejected.
- 7) ☒ Claim(s) 5, 13 and 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment/Remarks

1. Applicant's remarks filed on 5/3/04 have been fully considered but they are not persuasive. The Applicant presents an argument of which the Examiner has failed to establish a **prime facie** case of obviousness against Applicant's claims.

However, after careful scrutiny of Hurst, Jr. and Wee et al's references, the Examiner must respectively disagree, and maintain the grounds of rejection for the reasons that follow.

In response, Hurst, Jr (primary reference) fails to disclose a decoder for decoding each identified (out/in)-frame, a respective portion of the transport stream including the (out/in)-frame, and an encoder for re-encoding each decoded portion of the transport stream to produce a (out/in)-point adapter.

However, as discussed previously, decoding and re-encoding an input/output stream for splicing operation is well known in the art for a reason of seamlessly editing compressed image sequences together.

Furthermore, Wee et al (secondary reference) teaches decoding an identified out-frame, a portion of the video stream including the out-frame, and re-encoding each decoded portion of the stream for splicing purpose (col. 11, lines 19-32).

Therefore, it would have been considered quite obvious to a person of ordinary skill in the relevant art employing Hurst, Jr's reference to incorporate the well known concept of splicing operation as taught by the Wee et al so that the decoder decodes each identified (out/in)-frame, a respective portion of the transport stream including the (out/in)-frame, and the encoder re-encodes each decoded portion of the transport stream to produce a (out/in)-point adapter for a frame accurate splicing operation, thereby seamlessly editing compressed image sequences together.

Therefore, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was

within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 6-12, 14-20, and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hurst, Jr. (6,038,000) in view of Wee et al (6,104,441) as previously discussed in the last Office action as Paper 18.

Allowable Subject Matter

4. **Claims 5, 13, and 21** are objected to as being dependent upon a rejected base claims 1, 9, and 17, respectively, but would be allowable: if claim 5 is rewritten in independent form including all of the limitations of the base claim 1 and any intervening claims; if claim 13 is rewritten in independent form including all of the limitations of the base claim 9 and any intervening claims; and if claim 21 is rewritten in independent form including all of the limitations of the base claim 17 and any intervening claims. Accordingly, if the amendments are made to the claims listed above, and if rejected claims are canceled, the application would be placed in condition for allowance.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

6. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawn An whose telephone number (703) 305-0099 and schedule are Tuesday-Friday.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SSA 

Primary Patent Examiner

6/29/04